

## REMARKS

This substitute amendment is filed to correct the claim status identifier of claim 25 found in the original amendment filed October 7, 2008.

Claims 1-6, 8, 10, 12-22, 25, 27-29, 31, 33-42, 44, and 45 were pending and presented for examination in this application. In an Office Action dated July 7, 2008, claims 1-6, 8, 10, 12-22, 25, 27-29, 31, 33-42, 44, and 45 were rejected. In response, claims 1, 2, 4, 8, 10, 13, 14, 16-22, 25, 27-29, and 33-41 are amended and claim 42 is cancelled. Claims 1-6, 8, 10, 12-22, 25, 27-29, 31, 33-41, 44, and 45 are pending upon entry of this amendment. In view of the above amendments and following remarks, Applicants respectfully request that Examiner reconsider all outstanding rejections and withdraw them.

### **Response to Rejections under 35 U.S.C. 103**

In the 4<sup>th</sup> paragraph of the Office Action, claims 1-6, 8, 10, 12-22, 25, 27, 31, 33-42, and 44-45 have been rejected under U.S.C. 103(a) as allegedly being unpatentable over Klemmer ("Books With Voices: Paper Transcripts as a Tangible Interface to Oral Histories," CHI 2003, Fort Lauderdale, FL, Apr. 5-10, 2003, pp. 89-96) in view of Graham (U.S. Patent No. 6,369,811). In the 5<sup>th</sup> paragraph of the Office Action, claims 28-29 have been rejected under U.S.C. 103(a) as allegedly being unpatentable over Klemmer in view of Graham and Poncelleon (U.S. Patent Application No. 2003/0187642). These rejections now are traversed.

Applicants respectfully submit that use of the Graham reference is improper as the basis of this rejection under 35 U.S.C. §103(a). Graham was, "at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." 35 U.S.C. §103(c).

In view of 35 U.S.C. §103(c), Applicant respectfully submits that Graham cannot preclude patentability of the claimed invention because per that section:

**(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. (Emphasis added.)**

Graham is available under 35 U.S.C. §102(e) only. Graham was assigned to Ricoh Company Limited in an assignment recorded 12/08/1998 at reel 009623, frame 0403, attached as Exhibit A. The present application was assigned to the same Ricoh Company Limited in an assignment recorded on 3/30/2004, at reel 015172, frame 0907. A copy of this assignment is attached as Exhibit B for Examiner's reference. Graham and the present application both currently remain under these assignments.

Thus, the subject matter of Graham and the present application were, at the time the present application with the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. Thus, under 35 U.S.C. §103(c) the subject matter of Graham cannot preclude patentability of the claimed invention. Therefore, it is respectfully submitted that this basis for the rejection of claims 1-6, 8, 10, 12-22, 25, 27-29, 31, 33-41, 44, and 45 is improper and should be withdrawn.

Since it is admitted in the Final Office Action that Graham does not disclose several of the claim limitations recited in claims 51-6, 8, 10, 12-22, 25, 27-29, 31, 33-41, 44, and 45, and it is not asserted that any of Klemmer or Ponceleon, alone or in combination, discloses the limitations for which the Examiner relies on Graham, these deficient disclosures fail to establish

even a *prima facie* basis from which a proper determination of obviousness under 35 U.S.C.

§103(a) can be made.

Thus, Applicants submit that claims 1-6, 8, 10, 12-22, 25, 27-29, 31, 33-41, 44, and 45 are patentably distinguishable over the cited references.

In addition, the unavailability of the Graham reference as a basis of rejection under 35 U.S.C. §103(a) results in not all limitations of the pending claims have been substantively addressed in the pending Final Office Action, an error that substantially affects Applicants' ability to properly reply to the Final Office Action or to proceed to appeal.

### **CONCLUSION**

In sum, Applicants respectfully submit that claims 1-6, 8, 10, 12-22, 25, 27-29, 31, 33-41, 44, and 45, as presented herein, are patentably distinguishable over the cited references. Therefore, Applicants request reconsideration of the basis for the rejections to these claims and request allowance of them.

In addition, Applicants respectfully invite the Examiner to contact Applicants' representative at the number provided below if the Examiner believes it will help expedite furtherance of this application.

Respectfully submitted,  
Jonathan J. Hull et al.

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#### Total Assignments: 1

Patent #: [6569111](#) Issue Dt: 04/09/2002 Application #: 09149921 Filing Dt: 09/09/1998

Inventors: JAMEY GRAHAM, PETER E. HART

Title: AUTOMATIC ADAPTIVE DOCUMENT HELP FOR PAPER DOCUMENTS

#### Assignment: 1

Reel/Framer: [008230402](#)

Recorded: 12/08/1998

Pages: 3

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

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Exec Dt: 12/02/1998

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Exec Dt: 12/02/1998

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Reel/Frame: 015172/0907

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Total properties: 1

1 Patent #: NONE Issue Dt: Application #: 10014944 Filing Dt: 03/30/2004  
Publication #: US20050010400 Pub Dt: 01/13/2005

Title: Printable representations for time-based media

#### Assignors

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3 HART, PETER E.	Exec Dt: 03/29/2004

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